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OFFICE OF PETITIONS

PATENT

Attorney Docket No.: 015280-259120US

Client Ref. No.: E-002-96/2

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TOWNSEND and TOWNSEND and CREW LLP

By: Patricia Andrews

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SEP 16 2003

TECH CENTER 1600/2900

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

PASTAN et al.

Application No.: 09/684,599

Filed: October 5, 2000

For: MESOTHELIN, A  
DIFFERENTIATION ANTIGEN  
PRESENT ON MESOTHELIUM,  
MESOTHELIOMAS AND OVARIAN  
CANCERS AND METHODS AND KITS  
FOR TARGETING THE ANTIGEN

Customer No.: 20350

Confirmation No.: 2466

Examiner: Unger, Susan

Technology Center/Art Unit: 1642

PETITION FOR WITHDRAWAL OF  
ABANDONMENT OR,  
ALTERNATIVELY, PETITIONS FOR  
REVIVAL OF APPLICATION, AND  
PETITION FOR WAIVER OF RULES

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition for withdrawal of the holding of abandonment set forth in the Notice of Abandonment dated June 4, 2003, regarding the above-captioned application.

The Notice of Abandonment indicates that the application is abandoned due to Applicants' failure to respond to a Office letter mailed August 16, 2002. Counsel for the assignee, the Government of the United States, never received the August 16, 2002, Action (the "Action"), and to this date has not been informed of its contents.

09/03/2003 RUC:DRF1 00000045 201430 09594539

01 FD:1460 130.00 DD

## **I. Petition to Withdraw Holding of Abandonment**

### **A. Facts**

The PTO personnel issuing the Notice of Abandonment knew before the Notice of Abandonment was issued that the Applicants had not received the Action. During a telephone conference with the undersigned on April 3, 2003 to inquire whether Applicants had ever responded to the Action, Examiner Unger found the original August 16, 2003, Office communication in the Office's application file, along with the envelope addressed to Applicants' counsel, which showed that the communication had been returned to the Office by the U.S. Postal Service. Since the original Action was in the Office's file, the Examiner agreed it could not have been received by the Applicants. There is therefore no factual dispute that the Action never reached the Applicants. The envelope appeared to be correctly addressed and neither the undersigned nor Examiner Unger had an explanation for why the Postal Service returned the Action to the Office.

The undersigned assumed that the Action would be remailed with a new mail date, as provided by MPEP § 707.13. Examiner Unger later called the undersigned, however, and indicated that since the Action had originally been sent to the correct address, and there was no indication why the Postal Service had returned it, she had been informed that the proper procedure was to issue a notice of abandonment and to have Applicants petition for a withdrawal of abandonment, even though it was clear that Applicants had never received the communication.

### **B. MPEP § 711.03(c) II**

According to MPEP § 711.03(c), II. (8th Ed., Feb. 2003 Rev), an allegation that an Action was not received may be considered in a petition to revive an application. The section states that, if the Petition is adequately supported, the Office may grant the petition, withdraw the holding of abandonment, and remail the Action. MPEP § 711.03(c) II further indicates that, to minimize the burdens on practitioners and the Office, the practitioner must include a statement that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received by

the practitioner and providing a printout of the docket report as evidence that the Office action was lost in the mail rather than being lost after receipt of the Office action.

As noted in the preceding section, the Examiner has already confirmed that the Office action in question is in the Office's own file and therefore was not misplaced by Applicants or their counsel after its receipt. Nonetheless, for the sake of good order, Applicants make the required showing in the next section.

**C. Search of File Jacket, Docket, and Declaration that Firm has No Record of the Action Being Received**

As noted above, the examiner with responsibility for this application has already confirmed that the Office communication in question is in the Office's own files and was never received by the Applicants. Applicants therefore expect that the evidence required to demonstrate that the Office action was lost in the mail and not after receipt by the Applicants will be correspondingly reduced.

To comply with MPEP §711.03(c) II, however, the undersigned counsel hereby states that the Office communication was not received by the practitioner, and a search of the file jacket and docket records indicates that the Office communication indicates that the Office communication was not received. Further in compliance with MPEP §711.03(c) II, also enclosed with this Petition is a Declaration of Robyn Hess, the Manager of the International and Docketing Department for Townsend and Townsend and Crew, LLP. The Declaration states that all incoming mail from the Patent and Trademark Office (the "PTO") is directed to the attention of the U.S. Docketing Department and is calendared on a computerized docketing system. Ms. Hess further declares that she has reviewed the computer records with regard to the instant application and found no evidence that any communication was received from the PTO with regard to this application between Applicant's Amendment dated June 19, 2002 and the date of the Notice of Abandonment.

Also enclosed with this Petition are copies of (a) a docket report from the firm's computerized record, showing a search of the records for matters docketed for this application for the period August 16, 2002 (the mail date of the Office action in question) to August 25, 2007 and (b) a status report for the application showing previous items docketed (with the end of the shortened statutory period noted) and whether or not the required response was filed. Neither report shows receipt by the firm of the August 16, 2002, Action.

**D. Request for Withdrawal of Holding of Abandonment**

Applicants believe it to be uncommon for the Office to issue a Notice of Abandonment for failure to respond to an Office Action which the issuing Examiner knows was not received by the Applicants. Applicants submit that this unusual situation justifies the withdrawal of the holding of abandonment and respectfully request that the holding of abandonment be withdrawn so that the rights of the Applicants, and of the assignee, the Government of the United States, are protected to the maximum extent possible.

Applicants believe that no fee is due for a petition to withdraw a holding of abandonment under the facts of this case. If a fee is in fact due, however, the Commissioner is authorized to charge the fee to Deposit Account 20-1430.

**E. Petition for Waiver of Rules, if Necessary**

The present Notice of Abandonment does not reflect a failure to prosecute by the Applicants. Applicants clearly could not reply to a communication they never received. Should the Commissioner determine, however, that the petition to withdraw the holding of abandonment cannot be granted because of a failure to comply with one or more applicable rules, Applicants further petition the Commissioner under 37 C.F.R. §1.183 to suspend or to waive the rules to the extent necessary to permit withdrawal of the holding of abandonment. Should the Commissioner need to consider waiving requirements to grant the petition, as requested in this paragraph, the

Commissioner is authorized to charge the petition fee set forth at §1.17(h) to Deposit Account 20-1430.

## **II. Alternative Request to Consider this Petition as a Petition for Revival**

### **A. Request to Consider Present Petition as a Petition to Revive**

In the event that it is determined that the Petition to Withdraw the Holding of Abandonment cannot be granted, the Commissioner is respectfully requested to consider this a petition as a petition to revive an unavoidably abandoned application. Further, in the event that the petition cannot be granted as a petition to revive an unavoidably abandoned application, the Commissioner is respectfully requested to consider this petition as a petition to revive an unintentionally abandoned application. In the event that the Commissioner considers the petition under either of the alternative grounds set forth in this paragraph, Applicants authorize the Commissioner to charge the appropriate fee to Deposit Account 20-1430, and hereby state that the entire delay between the due date for the response and the filing of the instant petition was unintentional.

### **B. Petition to Waive Requirements of §1.137(a) and (b) in the event Petition is Considered as a Petition to Revive**

Applicants respectfully note that, under 37 C.F.R. §1.137(a) and (b), either of the petitions noted in the preceding paragraph requires submission of any response due with regard to any outstanding Office action. As set forth in Section I A of this paper, however, Applicants have still not received the August 16, 2002, communication and have never been informed of its contents. The very facts that necessitate the petitions herein, therefore, also make it impossible for the Applicants to comply with this provision of §1.137(a) and (b). Therefore, in the event that the Commissioner takes the present paper under consideration as a petition to revive the application for either unavoidable or unintentional abandonment, Applicants further petition the Commissioner under 37 C.F.R. §1.183 to suspend or to waive the provisions of §1.137 to the extent necessary to permit granting the petition. Should the Commissioner consider waiving the

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requirement for a response to the office action, as requested in this paragraph, the Commissioner is authorized to charge the petition fee set forth at §1.17(h) to Deposit Account 20-1430.

### **III. Conclusion**

If the reviewer has any questions or if a telephone conference would in any way advance consideration of this paper, the reviewer is respectfully invited to telephone the undersigned at 415/273-4744.

Respectfully submitted,

  
Laurence J. Hyman  
Reg. No. 35,551

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Attachments: Declaration of Robyn Hess  
Docket report  
Status report